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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/822,839   | 04/02/2001  | Masao Tsuruta        | Q60559              | 8477             |
| 7590   | 11/18/2003  |                      | EXAMINER            |                  |
| SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC<br>2100 PENNSYLVANIA AVENUE, N.W.<br>WASHINGTON, DC 20037-3213 |             |                      | DEXTER, CLARK F     |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 3724                |                  |

DATE MAILED: 11/18/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

|   |                                      |   |   |
|---|--------------------------------------|---|---|
| <b>Office Action Summary</b>  | Application No.<br><b>09/822,839</b> | Applicant(s)<br><b>Tsuruta</b>  |   |
|   | Examiner<br><b>Clark F. Dexter</b>   | Art Unit<br><b>3724</b>   |  |
| <i>-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --</i>  |                                      |   |   |
| <b>Period for Reply</b>   |                                      |   |   |
| <b>A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.</b>   |                                      |   |   |
| <ul style="list-style-type: none"> <li>- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.</li> <li>- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.</li> <li>- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.</li> <li>- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).</li> <li>- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).</li> </ul> |                                      |   |   |
| <b>Status</b>   |                                      |   |   |
| 1) <input checked="" type="checkbox"/> Responsive to communication(s) filed on <u>Sep 5, 2003</u>   |                                      |   |   |
| 2a) <input checked="" type="checkbox"/> This action is <b>FINAL</b> .   |                                      | 2b) <input type="checkbox"/> This action is non-final.                      |   |
| 3) <input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11; 453 O.G. 213.   |                                      |   |   |
| <b>Disposition of Claims</b>  |                                      |   |   |
| 4) <input checked="" type="checkbox"/> Claim(s) <u>1-4</u> is/are pending in the application.   |                                      |   |   |
| 4a) Of the above, claim(s) <u>3</u> is/are withdrawn from consideration.  |                                      |   |   |
| 5) <input type="checkbox"/> Claim(s) _____ is/are allowed.  |                                      |   |   |
| 6) <input checked="" type="checkbox"/> Claim(s) <u>1, 2, and 4</u> is/are rejected.   |                                      |   |   |
| 7) <input type="checkbox"/> Claim(s) _____ is/are objected to.  |                                      |   |   |
| 8) <input type="checkbox"/> Claims _____ are subject to restriction and/or election requirement.  |                                      |   |   |
| <b>Application Papers</b>   |                                      |   |   |
| 9) <input type="checkbox"/> The specification is objected to by the Examiner.   |                                      |   |   |
| 10) <input type="checkbox"/> The drawing(s) filed on _____ is/are a) <input type="checkbox"/> accepted or b) <input type="checkbox"/> objected to by the Examiner.<br>Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).   |                                      |   |   |
| 11) <input type="checkbox"/> The proposed drawing correction filed on _____ is: a) <input type="checkbox"/> approved b) <input type="checkbox"/> disapproved by the Examiner.<br>If approved, corrected drawings are required in reply to this Office action.   |                                      |   |   |
| 12) <input type="checkbox"/> The oath or declaration is objected to by the Examiner.  |                                      |   |   |
| <b>Priority under 35 U.S.C. §§ 119 and 120</b>  |                                      |   |   |
| 13) <input checked="" type="checkbox"/> Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  |                                      |   |   |
| a) <input checked="" type="checkbox"/> All b) <input type="checkbox"/> Some* c) <input type="checkbox"/> None of:<br>1. <input checked="" type="checkbox"/> Certified copies of the priority documents have been received.<br>2. <input type="checkbox"/> Certified copies of the priority documents have been received in Application No. _____.<br>3. <input type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).<br>*See the attached detailed Office action for a list of the certified copies not received.  |                                      |   |   |
| 14) <input type="checkbox"/> Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).<br>a) <input type="checkbox"/> The translation of the foreign language provisional application has been received.   |                                      |   |   |
| 15) <input type="checkbox"/> Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.  |                                      |   |   |
| <b>Attachment(s)</b>  |                                      |   |   |
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  |                                      | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |   |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  |                                      | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |   |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). <u>12</u>  |                                      | 6) <input type="checkbox"/> Other: _____                                    |   |

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## **DETAILED ACTION**

1. The amendment/response filed September 5, 2003 has been entered.

### ***Information Disclosure Statement***

2. The information disclosure statement filed November 6, 2003 (paper no. 12) has been received and the references listed thereon have been considered.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Monsees, pn 5,743,374, in view of Fujishiro et al., pn 3,595,370.

Monsees discloses an apparatus with almost every structural limitation of the claimed invention but lacks a means for turning the stacked sheets in a plane thereof. However, the Examiner takes Official notice that such turning devices are old and well known in the art and provide various well known benefits including providing a desired orientation of the stacked sheets for one or more subsequent operations; for example, to provide a specific orientation so

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that markings on the workpiece such as instructions, logos, etc. are oriented properly for shipping/packaging. Fujishiro is provided to show one example of such a turning means. Therefore, it would have been obvious to one having ordinary skill in the art to provide a means for turning the stacked sheets for the well known benefits including those described above.

5. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Monsees, pn 5,743,374, in view of Fujishiro et al., pn 3,595,370, as applied to claim 1 above, and further in view of Japanese Publication 1-210298 (hereafter JP '298).

The combination lacks a cutting unit as claimed. However, the Examiner takes Official notice that cutting units provided in sheet manufacturing lines are old and well known in the art for various well known benefits including providing cuts and/or cut-out portions in the sheet material for a desired sheet configuration. JP '298 provides one example of such a cutting unit. Therefore, it would have been obvious to one having ordinary skill in the art to provide a cutting unit on the apparatus of Monsees for the well known benefits including those described above.

#### *Response to Arguments*

6. Applicant's arguments filed September 5, 2003 have been fully considered but they are not persuasive. The Examiner respectfully maintains that the prior art teaches and/or fairly suggests the claimed invention. Contrary to applicant's argument, it is respectfully submitted that the Examiner has not only taken the position that the structure lacking in the base reference is known in the art, but has established a motivation/teaching for arriving at the claimed structure

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without the use of impermissible hindsight but rather by using what is taught by the prior art taken as whole.

*Conclusion*

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark Dexter whose telephone number is (703) 308-1404. The examiner's typical work schedule is Monday, Tuesday, Thursday and Friday, and he can be reached during normal business hours on these days.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Allan Shoap, can be reached at (703)308-1082.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)308-1148. The fax numbers Technology Center 3700 are: after-final responses - (703)872-9303; other formal/official papers - (703)872-9302. The fax number for informal/draft papers - (703)305-9835.



**Clark F. Dexter  
Primary Examiner  
Art Unit 3724**

cfb

November 17, 2003